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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,671	11/07/2000	Umesh J. Amin	2000-0107	9709

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EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,671

Applicant(s)

Amin et al.

Examiner

Rafael Perez-Gutierrez

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 28-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-15, 17-20, 22-25, 27 and 42 is/are rejected.
- 7) ☒ Claim(s) 16, 21, 26 and 43-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/5/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2686

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on September 28, 2004.

Claims 1-52 are still pending in the present application. **This Action is made NON-FINAL.**

Information Disclosure Statement

2. The information disclosure statement submitted on June 5, 2005 has been considered by the Examiner and made of record in the application file.

Drawings

3. The replacement drawing sheets filed on September 28, 2004 are accepted by the Examiner.

Claim Objections

4. **Claim 24** is objected to because of the following informality: On **line 2** of **claim 24**, replace "and" with --an-- before "attach". Appropriate correction is required.

Claim Rejections - 35 USC § 102

Art Unit: 2686

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 12-15, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Findikli et al. (U.S. Patent # 6,529,727 B1)**.

Consider **claims 1 and 18**, Findikli et al. clearly show and disclose a method for activating a mobile communication device in a wireless network (abstract), said mobile communication device being compatible with General Packet Radio Service (GPRS) (reads on **claim 6**) (column 4 lines 23-25) comprising:

establishing a data transmission link (i.e., a wireless link for the transmission of data such as an AMIN, IMSI, and/or MIN) between said mobile communication device and the wireless network (figure 6 and column 5 lines 49-54);

said mobile communication device receiving, via said data transmission link, at least one assigned operating parameter (e.g., MIN and/or IMSI) (reads on **claim 6**) (figure 6 and column 6 lines 4-34); and

storing said at least one assigned operating parameter in a memory element associated with said mobile communication device (column 6 lines 32-34).

Consider **claims 2 and 19**, and as applied to **claims 1 and 18** above, Findikli et al. further show and disclose that said memory element initially contains at least one temporary

Art Unit: 2686

operating parameter (e.g., AMIN generated from information stored in the subscription module 50) that facilitates operation of said mobile communication device in an activation mode (figures 1-3 and column 5 lines 54-63).

Consider **claim 3**, and **as applied to claim 2 above**, Findikli et al. also disclose that said storing step replaces said at least one temporary operating parameter (i.e., AMIN) with said at least one assigned operating parameter (e.g., MIN and/or IMSI) (column 6 lines 4-40).

Consider **claims 4 and 20**, and **as applied to claims 2 and 19 above**, Findikli et al. further disclose the step of transmitting an over-the-air activation (attach) request using said at least one temporary operating parameter (e.g., AMIN) (figure 6 and column 5 lines 36-54).

Consider **claims 12 and 15**, Findikli et al. clearly show and disclose a programmable module 50 (figures 1-3), configured as a Subscriber Identity Module (SIM) (reads on **claim 15**) (column 6 lines 51 and 52), for use with a mobile communication device capable of receiving data in accordance with a data transmission protocol (e.g., GPRS), said mobile communication device being compatible with General Packet Radio Service (GPRS) (reads on **claim 15**) (column 4 lines 23-25), said programmable module 50 (figures 1-3) comprising:

a memory element for storing at least one temporary operating parameter (e.g., AMIN generated from information stored in the subscription module 50) that facilitates operation of said mobile communication device in an activation mode (column 5 lines 54-63); and

an interface configured to receive at least one assigned operating parameter (e.g., MIN and/or IMSI) during said activation mode, wherein said mobile communication device receives said at least one assigned operating parameter over a data transmission link (i.e., a wireless link

Art Unit: 2686

for the transmission of data such as an AMIN, IMSI, and/or MIN) and in accordance with said data transmission protocol (e.g., GPRS) (figure 6, column 4 lines 23-25, and column 6 lines 4-34).

Consider **claim 13**, and **as applied to claim 12 above**, Findikli et al. further show and disclose that said memory element is further configured to stored said at least one assigned operating parameter (e.g., MIN and/or IMSI) (column 6 lines 4-40).

Consider **claim 14**, and **as applied to claim 12 above**, Findikli et al. also disclose that said memory element replaces (overwrites) said at least one temporary operating parameter (e.g., AMIN) with said at least one assigned operating parameter (e.g., MIN and/or IMSI) (column 6 lines 4-40).

6. **Claim 42** is rejected under 35 U.S.C. 102(e) as being anticipated by **Forslow (U.S. Patent Application Publication # 2003/009237 A1)**.

Consider claim 42, Forslow clearly show and disclose a method of activating a wireless device in a wireless network comprising:

attaching the wireless device to the wireless network (figures 2, 12, and 13 and paragraphs 0094-0105);

establishing a packet data protocol (PDP) context for the wireless device attached to the wireless network (figures 12 and 13 and paragraphs 0094-0105); and

providing activation options (e.g., DHCP offers) to the wireless device while the wireless device is in the PDP context (figure 13 and paragraphs 0101-0105).

Art Unit: 2686

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 5, 7, 17, and 22-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Findikli et al. (U.S. Patent # 6,529,727 B1)** in view of **Dusse et al. (U.S. Patent #**

Art Unit: 2686

6,647,260 B2).

Consider **claims 5, 7, and 17**, Findikli et al. clearly show and disclose the claimed invention except that the data transmission link is a wireless packet data transmission link (claims 5 and 17) and the step of transmitting, via said data communication link, information indicative of a number of service features selected by a user of said mobile communication device (claim 7).

In the same field of endeavor, Dusse et al. clearly show and disclose a method for activating a mobile communication device via a wireless packet data transmission link between said mobile communication device and a wireless network (column 3 lines 25-50 and column 4 lines 3-44) (reads on **claims 5 and 17**) and transmitting, via said wireless packet data communication link, information indicative of a number of service features selected by a user of said mobile communication device (abstract, figure 2, column 2 lines 4-51, and column 3 lines 25-50) (reads on **claim 7**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to activate the mobile communication device via a packet data link as taught by Dusse et al. in the method of Findikli et al. for the purpose of providing activation services for additional wireless architectures such as GPRS (Findikli et al; column 4 lines 23-25).

Consider **claims 22, 25, and 27**, Findikli et al. clearly show and disclose a method for activating a mobile communication device capable of receiving data in accordance with a packet data protocol (e.g., GPRS) (abstract and column 4 lines 23-25), said method comprising the steps of:

Art Unit: 2686

providing a programmable module 50 (figures 1-3) that is compatible with said mobile communication device, said programmable module storing at least one temporary operating parameter (e.g., AMIN generated from information stored in the subscription module 50) to facilitate operation of said mobile communication device in an activation mode (figures 1-3 and column 5 lines 54-63);

establishing a data transmission link (i.e., a wireless link for the transmission of data such as an AMIN, IMSI, and/or MIN) between said mobile communication device and a network support node during said activation mode (e.g., MSC 100, OTAF 400, and/or CSC 300) (figures 3 and 6 and column 5 lines 49-54);

transmitting, via said data transmission link, at least one assigned operating parameter (e.g., IMSI and/or MIN) to said mobile communication device (figure 6 and column 6 lines 4-34); and

storing said at least one assigned operating parameter at said programmable module (column 6 lines 32-34).

However, Findikli et al. do not specifically disclose that the data transmission link is a wireless packet data transmission link and the step of transmitting, via said data communication link, information indicative of a number of service features selected by a user of said mobile communication device (claim 27).

In the same field of endeavor, Duse et al. clearly show and disclose a method for activating a mobile communication device via a wireless packet data transmission link (reads on **claim 25**) between said mobile communication device and a wireless network (column 3 lines

Art Unit: 2686

25-50 and column 4 lines 3-44) and transmitting, via said wireless packet data communication link, information indicative of a number of service features selected by a user of said mobile communication device (abstract, figure 2, column 2 lines 4-51, and column 3 lines 25-50) (reads on **claim 27**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to activate the mobile communication device via a wireless packet data link as taught by Dusse et al. in the method of Findikli et al. for the purpose of providing activation services for additional wireless architectures such as GPRS (Findikli et al; column 4 lines 23-25).

Consider **claim 23**, and **as applied to claim 22 above**, Findikli et al., as modified by Dusse et al., further show and disclose that said storing step replaces said at least one temporary operating parameter (i.e., AMIN) with said at least one assigned operating parameter (e.g., IMSI and/or MIN) (column 6 lines 4-40).

Consider **claim 24**, and **as applied to claim 22 above**, Findikli et al., as modified by Dusse et al., also show and disclose the step of transmitting, from said mobile communication device, an over-the-air activation (attach) request using said at least one temporary operating parameter (e.g., AMIN) (figure 6 and column 5 lines 36-54).

Allowable Subject Matter

9. **Claims 16, 21, 26, 41 and 43-52** are objected to as being dependent upon a rejected base

Art Unit: 2686

claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments with respect to **claims 1-7, 12-28, and 42-52** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

Art Unit: 2686

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.



Rafael Perez-Gutierrez
R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**
PRIMARY EXAMINER

December 1, 2005